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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,225	05/03/2006	Matti Lares	043965/291580	7153
826 7590 09/09/2008 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER HUG, ERIC J	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 09/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/533,225

**Applicant(s)**

LARES ET AL.

**Examiner**

Eric Hug

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2007 and 28 April 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/28/2005  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson et al (US 6,022,448) in view of Kytonen et al (US 6,811,654) and Honkalampi et al (US 6,164,198).

Eriksson discloses making coated paperboard articles having one, two, or more layers and a coating thereon. The paperboard is calendered after coating with a soft extended nip, providing a board with reduced density and reduced grammage at a given value for bending force compared to corresponding coated paperboards which have been calendered otherwise with a hard or soft nip calender. One type of paperboard disclosed is liquid packaging board comprising at least three layers wherein the middle layer or layers provide high bulk and the outer layers have high tensile stiffness. Bleached sulfite pulp is preferred for the outer layers. This type of board product is deemed to be same as the claimed SBS board product.

Kytonen discloses methods for forming coated paper or board products which include the use of a long-nip shoe calender as a pre-calender prior to coating an uncoated web. Kytonen teaches the advantages of using a shoe calender as a pre-calender in board products such as taught by Eriksson above, thus, pre-calendering is deemed suitable for SBS board products. See

column 2, lines 11-25 and also see column 3, line 66 to column 4, line 7. Kytonen recognizes the advantages obtained in the method of Eriksson (WO 96/28609 is Eriksson), such as smaller reduction in density and basis weight without sacrificing flexural strength. Kytonen discloses that such webs pre-calendered using a shoe calender have improved surface smoothness while flexural strength remains almost at its initial level. When the web surface is smoother prior to the coating step, the amount of coating can be essentially reduced and/or the printability of the end product can be improved to a level exceeding that in Eriksson without losing the flexural strength or bulk of the web. For these reasons, it would have been obvious to one skilled in the art to pre-calender the web of Eriksson prior to coating to provide an SBS board product having improved smoothness in addition to the other advantages provided by a shoe calender.

In the examples given by Eriksson, the claimed values of density, basis weight (grammage), Bendtsen roughness, and gloss are met. Parker print surface roughness is higher than that claimed, but is deemed to be reduced to within the claimed levels when the board is subjected to the pre-calendering as taught by Kytonen. It would have also been obvious to one skilled in the art to reduce the roughness to as low a level as possible with the pre-calender in order to improve printability. It is also deemed that the claimed properties must be within certain specifications to qualify the board product as SBS board, thus it would have been obvious to one skilled in the art to pre-calender and coat the web in a manner to produce an SBS board product to within those certain specifications.

Honkalampi is cited here merely to show obvious details of a shoe calender, deemed to be exemplary of those found in shoe calenders such as employed by Eriksson or Kytonen, and which are not disclosed by Eriksson or Kytonen.

All other claimed steps, such as two-sided coating, two-sided calendaring, and/or moistening prior to calendaring are known practices by one skilled in the art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 16 of copending Application No. 10/533,004. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only differences between claimed method and that of 10/533,004 are the ranges of physical properties given for the respective board products. The ranges for density, basis weight, PPS roughness, and Hunter gloss overlap for the two products, therefore the claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/533,038. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only differences between claimed method and that of 10/533,038 are the ranges of physical properties given for the respective board products. The ranges for density, basis weight, PPS roughness, and Hunter gloss overlap for the two products, therefore the claims are not patentably distinct. All other claimed features of the instant invention are recited by 10/533,038.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lares (US 2003/0150581) discloses shoe calendering of board products without use of a Yankee dryer or wet-stack calender.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Hug whose telephone number is (571) 272-1192.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Hug/  
Primary Examiner, Art Unit 1791